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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/034,553	03/03/98	EDWARDS	S 1794-B-DIV-4

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EXAMINER

JASTRZAB, J

ART UNIT	PAPER NUMBER
3737	10

DATE MAILED: 08/02/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/034,553

Applicant(s)

Edwards et al.

Examiner

Jeffrey R. Jastrzab

Group Art Unit

3737



☒ Responsive to communication(s) filed on May 3, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 11-22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 22 is/are allowed.

☒ Claim(s) 11-21 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 5/3/99 have been considered but they are not fully persuasive. Applicant's arguments regarding the rejections based on 35 USC 112, 1st paragraph are persuasive, accordingly the rejections are withdrawn. However, in response to applicant's argument that the Stern reference does not teach or suggest an assembly for sensing and ablation, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, the Stern catheter electrode 14, (or electrodes 40), have the inherent capability of detection despite the disclosed use as ablation electrodes (claim 11). As to Claim 12, the term "substantially covering" is broad enough to encompass the Stern electrode(s) since they are, in size, substantial enough to perform ablation and detection. As to Claims 13, 15, 17, 19, and 21, Applicant's arguments are not persuasive, while the inclusion of ion beam assisted deposition in the apparatus claims is not prohibited, the method of attaching the material to the

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structure does not further limit the resultant apparatus absent a specific teaching in the specification that this particular deposition technique provides a resultant structure that differs structurally from that of known deposition techniques. As written the claims amount to a conductive material deposited on the exterior surface of the expandable structure, which is precisely the structure taught by Stern. As to Claim 14, note that in the embodiment of Figure 5, the separate conductive zones are usable in a bipolar mode, and would therefore be used as "individual electrodes". As to Claim 22, Applicant's arguments are persuasive and the rejection accordingly withdrawn. Similarly, in response to applicant's argument that the Perlin reference does not teach or suggest an assembly for sensing and ablation, it is contended that Perlin has an inherent ablation capability by merely attaching the catheter to an appropriate ablation source, and that if desired, both electrodes are capable of monopolar connection which meets the "individual sensing electrode" usage claimed.

Claim Rejections - 35 USC § 102

2. Claims 11-21 stand rejected under 35 U.S.C. 102(b) as being clearly anticipated by Stern '201.

3. Claims 11, 14, 18 and 20 stand rejected under 35 U.S.C. 102(b) as being anticipated by Perlin '239 (cited by Applicants).

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Allowable Subject Matter

4. Claim 22 is allowed.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Jastrzab whose telephone number is (703) 308-2097. The examiner can normally be reached on Monday through Friday from 6:30am to 3:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef, can be reached on (703) 308-3256. The fax phone number for this Art Unit is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0858.



Jeffrey R. Jastrzab
Primary Examiner
Group 3737

August 2, 1999